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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|------------------------------|------------------|
| 10/580,939 | 05/30/2006 | Robin Miheckun Miller | 60469-094PUS1; OT-5208LAB | 8921 |
| 64779 | 7590 | 06/04/2009 | | |
| CARLSON GASKEY & OLDS 400 W MAPLE STE 350 BIRMINGHAM, MI 48009 | | | | |
| EXAMINER | | | | |
| KRUER, STEFAN | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 3654 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/580,939

Applicant(s)

MILLER ET AL.

Examiner

Stefan Krueer

Art Unit

3654

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 29 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1 - 4, 7 - 12 and 21.
Claim(s) withdrawn from consideration: 14 - 16 and 18 - 20.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/John Q. Nguyen/
Supervisory Patent Examiner, Art Unit 3654

Continuation of 11, does NOT place the application in condition for allowance because:

Applicant's arguments are not persuasive with respect to the disclosures and teachings of the prior art as reviewed. Applicant's disappointment with the broad interpretation of the recitation "bonding agent adhesively securing" as being anticipated by the "snap-fit" of the reference of Rivera, wherein said "adhesively securing" is commensurate with "...tending to adhere or cause[ing] adherence" as postulated in the rejection of Claim 8 in the office action mailed 1 April 2009 is understood. Nevertheless, the interpretation in view of the claim language is reasonable.

Furthermore, with respect to the rejections of Claims 8 and 10 - 12 as being anticipated by the reference of Mier, applicant's arguments that the bonding agent of Mier is directed to a snap-fit construction as similarly disclosed by Rivera does not overcome the interpretation of the respective disclosures in view of the claim language..

With respect to the rejections of Claims 1 - 4, 7 - 9 and 21, applicant's arguments that neither the snap-fit of Rivera or Mier can be modified by the bonding agent of Martness, in that the construction of either Rivera or Mier is dissimilar to that of Martness and, as importantly, Martness is directed to the adhesive bonding of rail joints wherein the rails are for the transmission of "electrical signals or the like" and, therefore, an improper combination was made using hindsight reasoning, the features of the bonding agent of Martness, as drawn from a related field of application of Rivera and Mier, include damping and "... an inexpensive, low temperature adhesive bonding agent that reaches ... full strength quickly..."; thereby, an alternative to either of the bonding agents of Rivera or Mier with the additional feature of damping (and electrical insulation), if desired.

With respect to improper hindsight reasoning, the prior art of record incorporate the limitations and teachings as derived from their respective disclosures that establish and support reasonable motivation(s) to combine. Additionally, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

It is noted that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413,425 (CCPA 1981).

A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007).

"When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense." *Id.* It is not necessary that the inventions of the references be physically combinable, without change, to render obvious the invention under review. *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983).

A prior art reference must be considered for everything it teaches by way of technology and is not limited to the particular invention it is describing and attempting to protect. *EWP Corp. v. Reliance Universal Inc.*, 755 F.2d 898, 907 (Fed. Cir. 1985).

Finally, applicant has not argued the rejections of Claims 1 and 10 alone on their merits in view of the prior art of record. Furthermore, applicant has herewith cancelled Claim 13 without traverse.